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| FISH & RICHARDSON PC | | | EXAMINER | |
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RECORD OF ORAL HEARING
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD F. HAMILTON *et al.*

Appeal 2010-000657
Application 08/777,958
Technology Center 2600

Oral Hearing Held: Wednesday, January 12, 2011

Before MAHSHID D. SAADAT, JOHN A. JEFFERY and MARC S. HOFF,
Administrative Patent Judges

ON BEHALF OF THE APPELLANT:
CHARLES HIEKEN, ESQ.
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Application 08/777,958

1 *The above entitled matter came on for oral hearing on*
2 *Wednesday, January 12, 2011, commencing at 1:28 p.m., at the U.S. Patent*
3 *and Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Jan*
4 *Jablonsky, Notary Public.*

5
6 JUDGE SAADAT: Good afternoon, Mr. Hieken.

7 MR. HIEKEN: Good afternoon, Your Honors. May it please
8 the Board, this is an appeal from the final rejection of Claims 1, 3-6, 8-10,
9 directed to an audio speaker system in a vehicle as failing to meet the written
10 description requirement; Claims 1, 4-6, 9 and 10 as unpatentable under
11 Section 103(a) over Hathaway, or Hutchins, as a primary reference in view
12 of Virva as a secondary reference.

13 I'd like to discuss the written description in the prior claim
14 construction or the claim construction in the prior art evidence and law.

15 In terms of the written description, the Board at the last appeal
16 was dealing with a rejection that was based on lack of enablement, and came
17 out and described that the application as filed did provide enablement.

18 Since that time, I believe the Court has said there is a separate
19 requirement for written description as well as enabling, but if you look at the
20 language that the Board used in the prior decision, it embraces the written
21 description.

22 Also, this whole application as written is concerned with
23 providing support for the claims, and there is no question that with all the
24 drawings and language that's used in the specification, that the inventors had
25 possession of the claimed invention at that time.

26 In terms of claim construction, I think the Board in the prior
27 decision came out with what is perhaps a limitation that needs to be
28 understood by one of ordinary skill in the art from looking at the
29 specification, and that was recognizing that this is a negligible -- takes up
30 negligible volume in the trunk. It is at the rear of the trunk, not at the front.

31 If we go to the prior art, the Hathaway reference, which is used
32 to reject claims under Section 103 by itself, it clearly shows whatever

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1 structure is there at the front of the trunk. It looks like the driver is at least
2 the third the height of the trunk, then it shows this resonator that includes a
3 cavity one and then a port tube that connects it into the passenger
4 compartment through the rear deck.

5 If it's going to work that way, it has to be at the front of the
6 trunk where the rear deck is over the front of the trunk.

7 The other rejection is based on Hutchins as a primary reference
8 in view of Virva as a secondary reference. If we look at what Hutchins
9 discloses, Hutchins discloses the two rear speakers, from the bottom of the
10 bottom of the rear deck, which is exactly what the present invention teaches
11 you don't want to do.

12 Not only that, what it does, an important aspect of it, is it isn't
13 just having the two speaker drivers from the rear deck, the under side of the
14 rear deck, but it also puts in these additional enclosures, which it says
15 isolates the speakers from the trunk, and also provides some port, so you get
16 something like a base reflex effect.

17 How one can combine that with Virva, Virva is a secondary
18 reference, and that shows a speaker with an adjustable air column tube.

19 I gather the reason that the Examiner felt it could do something
20 is that it talks about having a nice flexible tube and so you could put a
21 speaker with a nice flexible tube in the trunk also, but while two of these
22 references recognize the importance of trying to not interfere with the useful
23 trunk volume, they don't show the claim structure that we have here, and if
24 you actually use their teachings, it would not involve having a negligible
25 occupation of the rear trunk volume.

26 I know this has been here before. All these references were
27 available at the prior hearing before the appeal was filed, but it was
28 uncovered after the Board's decision.

29 There is nothing wrong with trying to get the best prior art
30 before the Office, and as far as an applicant is concerned, that's why we have
31 these information disclosure statements all the time.

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It ought not to be a hunting license for the Examiner that's been reversed twice to go back and conduct another search and including as the first reference one where the Examiner was the Examiner of record. If you look there, it says Assistant Examiner Ping W. Lee.

It is our position that the decision of the Examiner finally rejecting these claims should be reversed, and hopefully at least, this patent will issue.

If there are no questions, I have nothing further to say.

JUDGE SAADAT: I don't have any questions. Do you?

JUDGE JEFFERY: No questions.

JUDGE SAADAT: Thank you so much.

MR. HIEKEN: Thank you very much, Your Honors.

(Whereupon, at 1:46 p.m., the proceedings were concluded.)

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